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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,917

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EXAMINER

SHAYANFAR, ALI

ART UNIT

PAPER NUMBER

2112

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/19/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

5

Office Action Summary	Application No. 10/608,917	Applicant(s) ARSHI ET AL.	
	Examiner Ali Shayanfar	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/26/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6, rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the part, "... *automatically re-addressing the email message to indicator...*", is not clear to readdress the email to an indicator. The email has to address to at least one email address in a list.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2112

Claim 1,2,4,7,10,11,12,13,14,18,19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiroshi Itoh (US 2002/0107930 A1).

In regards to Claim 1 and 12, Hiroshi Itoh shows a method of software for addressing the email message to the pre-determined distribution list;(Fig.8,112,114, Fig.9,202,206,207) and selecting a subtractive list, which when applied to the pre-determined distribution list, determines a modified distribution list comprising members of the pre-determined distribution list not present in the subtractive list.(Par.0025,0026,0032,0103,0119,0120, Fig.6, Fig7, Fig8,143, Fig9,207, Fig10).

In regards to Claim 2 and 13, Hiroshi Itoh shows providing the e-mail message to an e-mail server operable to distribute the e-mail message to the modified distribution list.(Par.0068, Fig,1, 20,21). The email server 20 or 40 will forward the address of an electronic message to the mail box at the mail address of each group, which in this case the group can be a modified distribution list.

In regards to Claim 4 and 14, Hiroshi Itoh shows applying the subtractive list to the pre-determined distribution list to determine the modified distribution list; and distributing the e-mail message to the modified distribution list.(Par.0025,0026,0032,0103, Fig.6,7,8,9,10).

In regards to Claim 7, Hiroshi Itoh shows distribution list is a selected one of: a manually created list, and an automatically generated list identifying members sharing a

Art Unit: 2112

common characteristic.(Fig 9,207). for example Football Club (A) is a group of individual who has common characteristic.

In regards to Claim 10 and 18, Hiroshi Itoh shows, receiving an e'mail message addressed to a first indicator for a pre-determined distribution list; comprising receiving at a user terminal an email being created by a user. (Fig 9,202), receiving a second indicator for a subtractive list (Fig 9, 206), which when applied to the predetermined distribution list, determines a modified distribution list .comprising member of the pre-determined distribution list not present in the subtractive list; and distributing the e-mail message via the email server to each member of the modified distribution list.(Fig7,207).

In regards to Claim 11 and19, Hiroshi Itoh shows first identifying, based at least in part on the first indicator, the members of the pre-determined distribution list (Fig.9, 202, Fig 8), second identifying, based at least in part on the second indicator, the members of the subtraction list; and determining the modified distribution list based at least in part on membership of the pre-determined list and the subtraction list. (Fig7,207).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3,5,6,8,9,15,16,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroshi Itoh (US 2002/0107930 A1).

In regards to Claim 3, Hiroshi Itoh teaches that the system is operable to apply the subtractive list to the predetermined distribution list to determine the modified distribution list. (Fig.9).

Hiroshi Itoh does not show that this functionality occurs in the e-mail server.

However, the examiner takes official notice that it is old and well known in the art to provide a web-based email service(e.g., Hotmail). It is further noted that in such an arrangement, the mail manipulation occur in the server instead of client.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hiroshi Itoh by providing web-based email, thereby manipulating the list in the server as taught by the old and well known prior art in order to reduce the workload in CPU of the computer decrease the operation in a user side.

In regards to Claim 5,8,15,17, Hiroshi Itoh show submitting at least an indicator of the pre-determined distribution list and of the subtractive list (Fig 9, 201, 202, 206, Fig 10).

Hiroshi Itoh does not show receiving from the email server data to facilitate distributing an email message.

However, the examiner takes official notice that it is old and well known in the art to provide a web-based email service (e.g., Hotmail, Yahoo). It is further noted that in such an argument, the data manipulation occurs in the server instead of client and that the server provides data to the client to facilitate email distribution.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hiroshi Itoh by providing a web-based email system, in order to decrease the use of memory in the user side station.

It is noted that in the web-based context, as discussed above, the email server is capable of manipulating list and distributing emails associated with the list, and therefore has the functionalities of list server.

In regards to Claim 9, Hiroshi Itoh shows that mail server 20 or 40 are forwarding address of the electronic message base on the destination and will also forward the email to the mailbox of the mail address of each group member(par,0068). It's inherent that the distribution server includes an email server functionality.

In regards to Claim 6 and 16, Hiroshi Itoh shows submitting at least an indicator of modified distribution list. (Fig 9, 201, 202, 206).

Hiroshi Itoh does not show that receiving from the email server an indicator of the modified distribution list; and automatically re-addressing the email message to an

Art Unit: 2112

indicator of modified distribution list, wherein the email server is operable to distribute the email message.

However, the examiner takes official notice that it is old and well known in the art to provide a web-based email service (e.g., Hotmail, Yahoo) so that it is capable of automatically re-addressing the email message to an indicator of modified distribution list, wherein the email server is operable to distribute the email message. It is further noted that in such an argument, the mail manipulation occurs in the server instead of client.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hiroshi Itoh by providing an email server, which can be capable of distribution operation and re addressing the email automatically.

By adding this feature user will just select different kind of operation which is desired in a GUI interface and the operation will be done in the server just like other web based application such as Mailman, and Yahoo Email mechanism. This will also decrease the use of memory in the user side station.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Shayanfar whose telephone number is 571-272-9739. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve McAllister can be reached on 571-272-6785. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ali Shayanfar



STEVE MCALLISTER
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